

No. 3050.

United States
Circuit Court of Appeals,
FOR THE NINTH CIRCUIT.

Louis M. Cole,

Appellant,

vs.

Ed. G. Hookstratten Cigar Com-
pany, a Corporation,

Appellee.

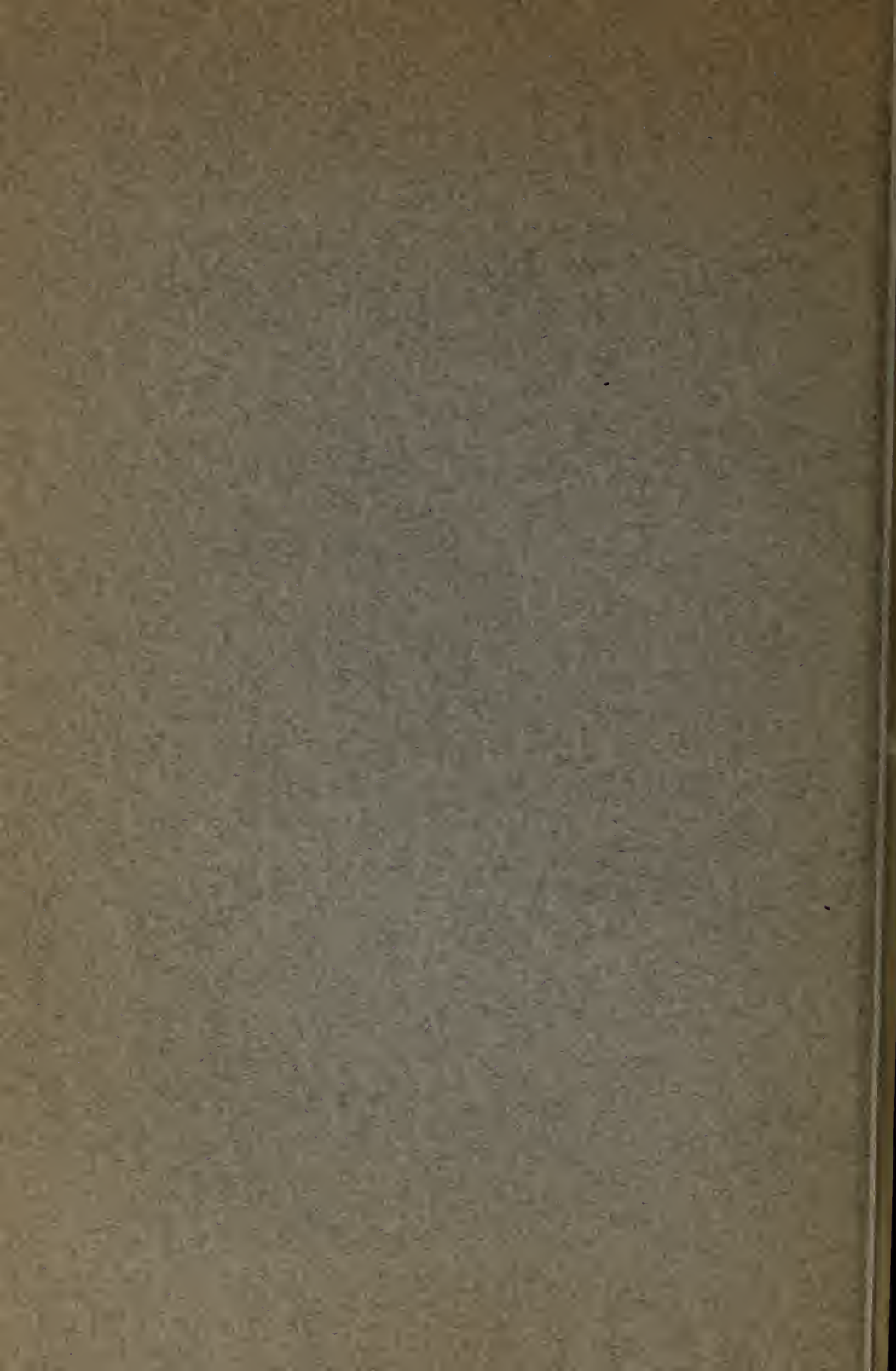
BRIEF FOR APPELLANT.

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BRIEF FOR APPELLANT.

STATEMENT OF THE CASE.

Appellant charges infringement of claims 2 and 3 of reissued Letters Patent No. 14,000, granted to Louis M. Cole for Label, a copy of the specification and drawings of which is to be found as Plaintiff's Exhibit I opposite page 32 of the Transcript.

A reference to such specification and drawings shows the subject-matter of the patent in suit to be a printed or lithographed paper label, which, while shown in the drawing as encircling a tin can, is not in any manner

limited to such cylindrical container, but may be used with any form of carton or package in which commercial products of various kinds are commonly distributed.

We cannot improve upon the language of claim 3 of the patent as a most clear and succinct description of the invention:

“3. As a new article of manufacture a label adapted to be detachably secured around a package, said label having display matter relating to the contents of the package on its outer face, the inner face of said label bearing useful printed matter, said label being provided on the outer face thereof with a line out of registry with said useful printed matter indicating where the label may be severed to remove the entire label without mutilating the printed matter on its inner face.”

Defendant stipulates [Transcript, bottom of pages 27-28] that it has made, used and sold prior to the institution of this suit packages of Wrigley's Spearmint Chewing Gum labeled like Plaintiff's Exhibit 2. An examination of this package (brought up as a physical exhibit under rule 34 of this court) will show that it is encircled with a label, which label, by reason of the printing on its inner face, forms when removed a coupon. The appellant contends that the language of said claims 2 and 3 of the patent in suit read literally upon this chewing gum package, and thus establishes infringement. This with the admissions of the answer (not material to be here specifically referred to) constitutes plaintiff-appellant's case.

The usual defenses of want of invention, anticipation by prior patents and by prior public use, and non-infringement are pleaded, as well as the more unusual one that the reissue claims are invalid because of having been broadened.

Defendant's Exhibits K to S, inclusive, are, with the exception of the first, which is a label of Star Brand Condensed Milk, soap wrappers and have all been stipulated as having been made and publicly used and sold in various parts of the United States prior to the date of invention of the subject matter of the patent in suit.

It was also stipulated [Transcript page 25] that the Zeno Manufacturing Company of Chicago, Illinois, publicly used, prior to the date of invention of the Cole device, labels such as shown opposite Transcript page 59, wherein an adhesive was so applied near the meeting ends of the labels as to leave one edge free whereby the label might be readily removed by pulling back the free edge.

As very pertinent to an understanding of the issues, we also called the court's attention of the stipulation [Transcript, page 25]—

“that Wm. Wrigley, Jr. Company of Chicago, Illinois, publicly used prior to January 1, 1908, labels adapted to be wrapped around five sticks of chewing gum and having their meeting edges secured together by means of an adhesive which was applied behind one of the edges so as to leave a free edge whereby the label might be readily removed from the package. It is further stipulated, however, that insofar as the Wrigley

label is concerned, this company did not, prior to January 1, 1908, employ a label with a coupon or profit-sharing certificate printed upon the inside thereof, nor did it print a label with the words, "Remove carefully—Pull back here," printed thereon. A package of chewing gum containing a label as used by Wm. Wrigley, Jr. Company prior to January 1, 1908, is hereto attached to this stipulation, it being admitted, however, by the defendant that such prior label was not in coupon form as above noted."

A number of specifications and drawing of prior letters patent (constituting Defendant's Exhibits C to I, inclusive) were stipulated into evidence in the attempt to show want of invention, anticipation, or a necessity for narrow interpretation of the claims in suit.

While, as stated, the answer pleads invalidity of the reissue on account of the broadening of the claims, and contains a denial of performance of the conditions precedent to the granting of a valid reissue of letters patent, no other evidence upon any of such suggested issues was introduced, unless by some possibility defendants should contend that the same is contained in the copy of the file wrapper contents of the original and reissued letters patent.

The court, as the final decree [Transcript, page 17] and the opinion of the court [Transcript, page 19] will show, held the claims sued on valid but not infringed, and the only finding which we contend to be an error now relied upon by appellant is the failure of the trial court to find infringement, and to award the usual injunction and accounting.

THE ISSUES.

The defendant-appellee will no doubt attempt to support the court's finding of non-infringement.

The combination of elements of the claims in suit is not found in any of the labels, wrappers, or patent drawings and specifications put in evidence by defendant-appellee. There is, therefore, no room for any contention on the part of appellee that the subject-matter of the claims in suit is anticipated. Defendant's prior art showing, however, will doubtless be used in an attempt to support an argument that the combination of the claims is void for want of invention. We anticipate no contention that all conditions precedent to the granting of valid reissued letters patent were not complied with, because the record contends no evidence attacking the usual presumption of validity on this score.

The only defenses, therefore, which will be urged on this appeal, so far as we can foresee, are: (1) non-infringement; (2) want of invention; and possibly, (3) invalidity of the reissue because of broadened claims.

Infringement.

It is believed that a comparison of the language of claims 2 and 3 of the reissued letters patent in suit with defendant's package of Wrigley's Spearmint Chewing Gum (Plaintiff's Exhibit 2) will convince the court of the validity of appellant's contention that such claims read literally and precisely upon defendant's label.

The element described as “a line out of registry with said useful printed matter indicating where the label may be severed,” reads either on the line formed by the free edge of defendant’s label just below the words “Remove carefully—Pull back here” or upon either the waved line beneath, or the straight line above, said words.

There might at first glance appear to be some room for construing the word “line” as indicating a printed mark on the label and as not applicable to the edge of the label which when pasted in place forms the line. Such a construction, however, would not be tenable because, in the first place, it would not be consistent with the specification and drawings, in the light of which, in accordance with elementary law, the claim must be construed; for the specification at line 67, page 1, distinctly says: “The line for cutting the label is *preferably* located to one side of the lapped ends, so that the cut need only be through a single thickness of paper * * *.” Patentee thus distinctly recognizes that the line may exactly abut the end of the label or may be slightly beneath the end of the label, so long as the words “cut on this line,” or words of similar import, appear adjacent thereto.

To construe, therefore, the word “line” of the claim as a printed line only, and not also the line formed by the end of the label, would be confining the patentee to what he described merely as a “preferable” construction, and further, would ignore the well settled law that a change of form does not avoid infringement.

In the 5th edition of Walker on Patents, page 453, section 363, it is said:

“A change of form does not avoid an infringement of a patent, unless the form shown in the patent is necessary to the functions which the patent ascribes to the invention; or unless that form is the distinguishing characteristic of the invention; or is essential to its patentability; or unless the patentee specifies a particular form as the means by which the effect of the invention is produced; or otherwise confines himself to a particular form of what he describes. Even where a change of form somewhat modifies the construction, the action or utility of the patented thing, non-infringement will seldom result from such a change.”

Under section 365, page 454, Walker on Patents (5th edition), the author collects and analyzes the cases upon this particular phase of the patent law.

We also respectfully urge that if the word “line” of the claim means “printed line” and is not fully met by the printed lines on defendant’s label, both above and below the words “Remove carefully—Pull back here,” the patentee, being entitled to all equivalents of each of the elements of his combination, is entitled to a decision that the line formed by the edge of the paper of the defendant’s label performs the same function in substantially the same manner, and constitutes substantially the same means as the printed line illustrated in the Cole drawings, and is, therefore, the mechanical equivalent of such printed line.

There seems to be some suggestion in the opinion of the trial court that the word “sever” of the claim

might be construed as “cut” and that, therefore, defendant’s label, which is not cut, but which is pulled apart, would not properly be described by the language of the claims.

We are convinced that such an interpretation is not a logical one nor required by the specification and drawings or the state of the art.

It is unnecessary to remind the court of the elementary canon of construction that words are to be understood in their ordinary and common signification. The word “sever” is a broader term than “cut.” It was obviously selected because it covered both tearing apart in any manner as well as cutting. In the Standard Dictionary we find “sever” defined as—

“3. To divide, cut, or sunder into two or more parts; cleave asunder; as to sever a knot or rope. To make a division or separation.”

“Sunder” is defined by the same authority as follows:

“To dissolve or prevent connection between; break; part; disunite. Division into parts; separation.”

No reason is suggested why the word “sever” in the claim should be given any other than its ordinary and common meaning.

The inventive idea of the patent in suit did not reside merely in the specific manner of the separation of the ends of the label. The essence of the invention is surely as fully appropriated by an infringer who provides for the tearing apart or pulling apart of the

label at the indicated point as by he who cuts it with a knife.

To summarize our contentions on the question of infringement: The claims in suit are directed to a specific combination of elements and are narrow, limited claims. Their language is untechnical and perfectly intelligible, even without recourse to the aid of the specification and drawings. Neither the state of the art nor any other portion of the patent contract requires any narrowing or any forced or unnatural interpretation of the language used. Giving to the words their usual, ordinary, non-technical, and proper signification, they read plainly both in letter and in spirit upon defendant's label. It is, therefore, respectfully urged that the finding of the trial court of non-infringement is erroneous.

Alleged Anticipation.

Defendant's Exhibits L to S, inclusive, are soap wrappers. There is no evidence nor stipulation that any of them is "detachably *secured*" around its respective package, as called for by the claims in suit. Being mere loose wrappers held in place by folding, none of them have "a line * * * indicating where said label should be severed to remove the entire label without mutilating the printed matter on its inner face," as described in the claims. Owing to the method of use of such wrappers, no line indicating where the label should be severed is required.

The object of such printed line as shown, for instance, on Defendant's Exhibit N (Babbitt's Best Soap), is not to provide for severing which will per-

mit the "entire label" to be removed without mutilation, because the entire label is plainly designed to be removed without cutting or severing—by merely unwrapping or unfolding before the coupon is cut out. When such soap wrappers are unfolded and removed from their respective packages the method of separating the useful printed portions is not different in principle from the method of using the ordinary coupon bond. After removing they do not come within the description of "detachably secured" labels; they are mere *unattached* papers, and their printed lines and directions for cutting out portions only come into use when they have *ceased to be labels*.

We do not see that any of these soap wrappers advance defendant's case in the slightest, because the most they show is that one or two elements of the patented combination was old. This establishes no more than the law conclusively presumes. As stated by Hopkins on Patents, Vol. I, page 122:

"In a combination claim, as a matter of law, every element is conclusively presumed to be old, whether or not it is old in fact. As Mr. Justice Brown has said: 'The failure to claim either one of the elements separately raises a presumption that no one of them is novel.'"

Citing:

Richards v. Chase Elevator Co., 159 U. S. 477,
486, 40 L. Ed. 225, 228.

In the case of Defendant's Exhibit K (Star Milk Label) no indication is contained on the label as to

how it is to be removed from the can. So far as the evidence discloses, the label may be pasted its entire length around the container and it may be necessary to remove it by soaking. It is not shown to be "detachably secured," in the sense of the patent in suit, to the container. It has no line indicating where the label may be severed to remove the *entire label* as called for by the claims.

In our examination of the patented art, as shown of record, it is important to note that the two nearest references, i. e., Defendants' Exhibit G (Martin and Fietsch Patent No. 1,004,055) and Defendant's Exhibit J (Braly Patent 589,406) were cited and fully considered by the patent office examiner on the Cole reissue application [Transcript, page 49]. These references are surely much more pertinent than either the soap labels or the Star Milk label. The patent to Braly is particularly to be noticed for it shows a portion of a label described as having printed matter on both sides with perforations indicating where the label may be torn to remove the desired portion. The Martin and Fietsch patent shows only a detachable trading stamp forming part of a label.

A comparison of the language of the claims in suit shows very clearly that they do not read on any patented art. The most that can be said concerning this so-called prior art is that one of these patents show one feature of the combination of the claims in suit and another another feature, etc. Does this not make clearly applicable the law as announced by this court

in *Stebler v. Riverside Heights Orange Growers' Association*, 205 Fed. 735?

"True, we may pick out one similarity in one of these devices, and one in another, and still one in another, and by combining them all, anticipate the inventive idea expressed in the Strain patent, but the combination constituting the invention is not found in any one of them. As we had occasion to say in *Los Alamitos Sugar Co. v. Carroll*, 173 Fed. 380: 'It is not sufficient to constitute an anticipation, that the device relied upon might by a process of modification, reorganization, or combination, be made to accomplish the function performed by the device of the patent.' Citing *Western Electric Co. v. Home Telephone Co.*, 85 Fed. 649; *Topliff v. Topliff*, 145 U. S. 156; *Gun v. Bridgeport Brass Co.*, 143 Fed. 239; *Ryan v. Newark*, 96 Fed. 100; *Simonds R. M. Co. v. Hawthorn Mfg. Co.*, 90 Fed. 201-209; *Gormully & J. Co. v. Stanley Cycle Co.*, 9 Fed. 379; *Morrow v. Shoemaker*, 59 Fed. 120."

At page 264, Sec. 213, rule XXI, Hopkins on Patents says:

"IT DOES NOT CONSTITUTE ANTICIPATION OF A COMBINATION TO FIND EACH OF ITS ELEMENTS IN SOME STRUCTURE OF THE PRIOR ART. (Here, quoting the language of Putnam, J., in *Heap v. Tremont and Suffolk Mills*, 82 Fed. 449): 'It is probably very true that by selecting from the various prior machines in this particular art, all the elements of the device in suit could be brought together. But to hold that this fact always defeats novelty would be to shut out every combination of old elements from the protection of the patent laws.

A combination (quoting Welker, J., in Worswick Mfg. Co. v. Steiger, 17 Fed. 250, 252) can only be anticipated by a prior device having identically the same elements *or the mechanical equivalents of these that are not used*. It will not do to find in older devices a portion of these elements in one machine, another portion in a second machine, another in a third, and so on, and then say that this device is anticipated.’”

Measured by these elementary and well settled rules, it is submitted that defendant’s showing of the prior art utterly fails to establish the defense of anticipation.

Invention.

It has been the experience of all modern nations that wise and well administered patent laws are by far the most effective stimulus to the advancement of our material civilization.

It is believed that the wonderful development of the modern industrial arts must be attributed almost exclusively to the protection we afford our inventors. The greatest good demands a broad and liberal application of such laws with their reason and spirit ever in view, and an earnest effort on the part of our courts to uphold, wherever possible, patents brought before them for adjudication. Any one who has given the subject consideration will have found our patent office with its examination system the most efficient in the world. Special training and superior fitness to determine questions of patentability are required of our patent office examining corps. The allowance of a patent by such

eminently qualified tribunal constitutes an adjudication of patentable invention and novelty, which, we submit, should be accorded the greatest weight and respect. The court should be at great pains to avoid stultifying a solemn act of the Government of the United States through such specially constituted patent office tribunal.

The presumption is that the examiner gave careful consideration and accorded due weight to all pertinent patent art, and we have the positive evidence of the file wrapper contents that the closest references—those we contend, much nearer than anything now specially insisted upon by defendant—were carefully weighed by him. There is no new evidence in the present record which might have changed the examiner's opinion. We respectfully urge, therefore, that under such circumstances any doubt in the mind of the court should be resolved in favor of the patentee, and the presumption of validity should prevail.

The affirmative of this question of invention is always an awkward one to handle, for by what test shall we determine where to draw the line between invention and mere mechanical skill? Surely the simplicity of the device furnishes no argument of want of invention; for the mechanical skill which designs, constructs and assembles the most complicated modern machinery receives a very trifling compensation as compared with the golden reward which is lavished by that great judge of inventive worth, the general public, upon the originators of such simple devices as the safety pin, the crimped hair pin, the rubber on

the end of a pencil, barbed wire, the point of a tooth pick, the paper clip, the toy wooden ball attached to a rubber band, and many others.

In *Webster Loom Co. v. Higgins*, 105 U. S. 580, the court, after stating that it could not assent to the argument that the combination of different parts or elements for attaining the object in view was so obvious as to merit no title to invention, remarks:

“Now that it has succeeded, it may seem very plain to anyone that he could have done it as well. This is often the case with inventions of the greatest merit.”

In *Western Mineral Wool Co. v. Globe Mineral Wool Co.*, 75 Fed. 400, near the bottom of page 402, the court said:

“The claim is now made, as has frequently been the case, that the process covered by the invention is so plain and simple as to exclude the possibility of inventive genius. But why was it never resorted to before, if so simple? Why not used, if so plain? It may be simple, yet nevertheless an invention, and while now very plain it is still meritorious.”

But we struggle with the feeling that we are arguing matters of law frequently applied and well understood by this court. Take, for instance, the case of *Diamond Patent Co. v. S. E. Carr*, 217 Fed. Rep. 400, in which this court fully considered a similar question involving the validity of the *Weber All-Glass Show Case Patent*. The structure of the patent was made of plates of glass secured together by thin and narrow strips of felt coated with cement. In the attack upon the validity

of the patent for want of invention and for anticipation, it was shown that all-glass show cases were old and that the use of cement-coated felt strips to secure their plates together was old. Weber's only contribution to the art seemed to be his "superficially coating" of the strips of felt with cement,—which was necessary to preserve their resiliency. The court very properly in that case found invention to reside in the making of resilient what was not resilient before—in merely altering the character of the adhesive.

On page 405 it was said:

"Nor is anticipation made out by a device which might, with slight modification, be made to perform the same function. The invention must be complete and capable of producing the result. One should not be deprived of the results of a successful effort merely because someone else has come near it."

Bringing to bear the best light possible on this question of invention, we believe it will be found that the decision of the patent office examiner was sound, and that the claims present a clear margin of patentable invention over all prior art now cited.

Conditions Precedent to Reissue Complied With.

In support of the assertion of this heading, and in the absence of something more than the mere denial of defendant's answer of the allegations of the complaint as to compliance with conditions precedent to the issuance of reissued letters patent, we submit the showing made by the file wrapper contents of both

the original and reissued letters patent. There has been no attempt to rebut the usual presumption of regularity of all proceedings leading up to the grant of the patent in suit.

Broadening Claims of Reissue to Cover Real Invention.

While, as before stated, this alleged defense is pleaded in the answer, it was not urged on the trial, and it is not believed that it will be pressed on this appeal.

It will be noted from the oath forming part of the reissue application [Transcript, bottom of page 47] that the reason given for the surrender of the original patent and the application for the reissue was "that the specification thereof is defective and that such defect consists particularly in the claims which do not cover [applicant's] invention." The applicant further stated upon oath:

"That the errors which render said patent inoperative arose from inadvertence without any fraudulent or deceptive intention on the part of deponent; that the following is a true specification of the errors which it is claimed constitutes such inadvertence, relied upon:

"Deponent, not being versed in the phraseology of claims, was deceived into thinking that the said claims covered his invention and protected him to the fullest extent under the law; whereas the claims are in fact faulty and erroneous in specifying the label as loose and including the flanged construction of the can."

The reissue application is thus based flatly upon the insufficiency of the claim of the original patent on account of its narrowness.

As a comparison of dates will show, the reissue application was filed several months less than two years after the granting of the original patent. No question of intervening rights is raised in the record.

We believe that the great weight of modern authority will sustain the proposition that any failure to secure in the original patent the invention to which the applicant was entitled, which was not the result of a deliberate act, or was not the result of an intention to deceive, may be attributed to inadvertence, accident or mistake.

One of the most thoroughly considered cases on reissue is that of *Crown Cork and Seal Co. v. Aluminum Stopper Co.*, 108 Fed. 845, decided by the Circuit Court of Appeals for the Fourth Circuit. In that case the court said:

“A review of the earlier decision of the Supreme Court would seem to show that by ‘defective or insufficient specifications’ was meant any failure to describe or claim the complete invention upon which the application for the patent was founded, and that ‘inadvertence, accident, or mistake’ was used in antithesis to fraudulent intent, and that the right to reissue depends upon any failure to make the specification and claims legally adequate for their purpose, if due to any cause except an intention to deceive.”

In the case just quoted from there was a broadened claim and no showing of any particular inadvertence,

accident, or mistake except an allegation that the application papers were hurriedly prepared, and that neither applicant nor his attorneys noticed the defects throughout the years of the prosecution of the application.

In the case of *Houghton v. Whitin Machine Works*, 153 Fed. Rep. 740, it was held by the Circuit Court of Appeals for the First Circuit, that the failure to make the claims of sufficient scope may be regarded as inadvertence, accident, or mistake. In *Moneyweight Scale Co. v. Toledo Computing Scale Co.*, 187 Fed. Rep. 826, the Circuit Court of Appeals for the Seventh Circuit said:

“The original specification alone on its face was sufficient proof that, if a claim adequate to cover the improved scale was never drawn, the failure came from the lack of an attentive comparison of the submitted claims with the invention particularly pointed out in specification. This was inadvertence, ‘lack of heedfulness or attentiveness’ irrespective of the real competence or incompetence of the solicitors.”

Very few inventors understand the nature of a patent claim. It is the most difficult part of the specification to draw with accuracy. Courts have taken these things into consideration in permitting inadvertence in failing to claim the real invention to be corrected by reissue. There can be no doubt under the authorities that broadened reissues are permissible.

Conclusion.

In conclusion we urge that the claims in suit both in letter and in spirit read on defendant's labels; that their combination of elements is not found in any prior art device in evidence; that the evidence shown by the file-wrapper contents of the patent in suit to have been considered by the patent office examiner who allowed the reissue claims, is stronger and more pertinent than any of the alleged anticipations now before the court; that the adjudication of the patent office in granting the patent, should, under such circumstances, be affirmed, and the usual presumption of validity of the reissue should prevail.

An examination of the file-wrapper contents shows every step upon which the validity of the reissue might depend to have been fully complied with, and the law is well settled that broadened reissues, under the circumstances of the present case, are permissible.

It is respectfully submitted that the claims in suit are valid and infringed, and that the decree of the trial court should be reversed with costs.

Respectfully submitted,
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